

## ***Remarks***

In the Examiner's Communication, the Examiner has alleged that Applicant failed to fully respond to the Request for Information. In general, Applicant disagrees with this assessment and believes that the original response provided the information that was reasonably necessary to the examination of this application. However, after conversations with both the Examiner and the Examiner's supervisor, Dr. Ardin Marschel, and without conceding any deficiency of the original response, Applicant provides the following information to assist the Examiner.

### ***Examiner Interview***

During an Examiner Interview on July 6, 2005, Applicant's representative discussed the Examiner's Communication with Examiner Marschel. Applicant pointed out that much of the request was beyond the scope of that which was reasonably necessary to the examination of the application, for example, but not limited to, the request to "stat[e] specific improvements of the subject matter in the claims and indicat[e] the specific elements in the claimed subject matter that provide those improvements." Examiner Marschel pointed out the difficulty faced by the examiners in this and related art units to effectively locate prior art. Thus, in the spirit of cooperation, Applicant agreed to provide the following supplemental information to assist the Examiner with examining the application.

#### **A. Document Submission.**

Accompanied herewith are copies of the references identified in the prior response to the Examiner's request for information for which copies were not provided. These copies are provided on a compact disc for the convenience of the Examiner.

#### **B. Users Manuals in View of Claimed Invention.**

With regard to the GeneSight User's Manuals ("User Manuals") provided earlier, none of the User Manuals appears to disclose the claimed invention. Neither the User Manuals published prior to the filing date of the above-mentioned application nor the

User Manuals published after the filing date of the above mentioned application disclose all of the features of the claimed invention.

In the statement submitted in the Response to Request for Information, submitted December 6, 2004, Applicant stated that the GeneSight 3.0 product was the first to incorporate the Applicant's invention, but made no reference to whether the User's Manual that accompanied this product disclosed the invention.

To assist the Examiner with examining this application, Applicant directs the Examiner to the following portions of the User Manuals which deal with clustering, but makes no representation regarding the presence of clustering information elsewhere in these User Manuals:

GeneSight Users Manual, Version 1.3b at pages 25 – 33;  
GeneSight Users Manual, Version 2.1 at pages 209 – 218;  
GeneSight Users Manual, Version 3.0 at pages 227 – 236;  
GeneSight Users Manual, Version 3.1.3 at pages 235 – 244;  
GeneSight Users Manual, Version 3.5 at pages 235 – 244;  
GeneSight Users Manual, Version 4.0 at pages 305 – 314; and  
GeneSight Users Manual, Version 4.1 at pages 291 – 300.

**C. Application Note GS10**

With regard to Application Note GS10 provided earlier, this reference does not disclose all of the features of the claimed invention. A discussion of clustering analysis begins on page 1 of this document and ends on page 6 of this document.

**D. SAS/STAT 9.1 User's Guide**

As stated above, Applicant has included a copy of the SAS/STAT 9.1 User's Guide ("SAS Document") on the accompanying compact disc. Applicant notes that the publication date of the SAS Document is later than the filing date of the above-referenced patent application. Therefore, the SAS Document is not prior art

under 35 U.S.C. §102. Accordingly, this reference is not relevant to the patentability of the claimed invention, and no further comments are warranted.

**E. Herrero *et al.* and Eisen *et al.***

As stated above, Applicant has included copies of Herrero, Javier, *et al.*, "A Hierarchical Unsupervised Growing Neural Network for Clustering Gene Expression Patterns," Bioinformatics, vol. 17, no. 2, pp126-136, 2001, ("Herrero *et al.*") and Eisen, Michael B, *et al.*, "Cluster Analysis and Display of Genome-Wide Expression Patterns," Proc. Nat'l. Acad. Sci. USA, vol. 95, pp. 14863-14868, Dec 1998, ("Eisen *et al.*") on the accompanying compact disc. Neither of these references discloses all of the features of the claimed invention. A discussion of clustering analysis algorithms in Herrero *et al.* appears to begin on page 127 of Herrero *et al.* and continues through the end of the document. A discussion of clustering analysis algorithms in Eisen *et al.* appears to occur on page 14864 of Eisen *et al.* Applicant makes no representation regarding the presence of clustering information elsewhere in these documents.

**F. Means Plus Function Claims**

To the extent that sufficient structure is not recited in the claims such that features of the claimed invention are interpreted under 35 U.S.C. §112 sixth paragraph, and to the extent that the Examiner has requested reference to structure recited in the specification in support thereof be clarified, Applicant notes that paragraphs 15 and 27 provide structure in the form of software modules and/or computer program code embodied in a computer readable medium and/or enabling a processor to perform one or more of the functional elements recited in claims 1 or 28.

Other structure may be recited elsewhere in the specification supporting these and/or other features of the claims.

**G. Improvement Discussion in the Specification**

In response to the Examiner's request for citation to specific portions of the specification pointing out improvements of the claimed invention, Applicant directs the

Examiner to *at least* paragraph 30 of the specification. Other portions of the specification may discuss improvements provided by the claimed invention.

### Conclusion

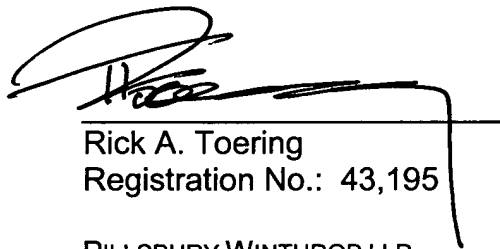
Applicant believes that a full and complete response has been made to the original request to the extent that information complying with the request was reasonably necessary to properly examine or treat the matter or was readily available.

Applicant further believes that this additional information will assist the Examiner with the examination of the application. To the extent that the Examiner still requires yet further information, Applicant requests that the Examiner contact Applicant's representative at her earliest convenience.

Applicant requests favorable action with regard to the pending claims. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned representative at the number provided.

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Respectfully submitted,



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